

## REMARKS

In the Office Action mailed December 22, 2008, the Examiner rejected claims 18-20. By way of the foregoing amendments and the markings to show changes, Applicants have amended claims 18 and 19, cancelled claim 20, added new claims 30-38, with claims 21-29 being withdrawn. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

### I. Restriction Requirement

Applicants reserve the right to pursue divisional applications and request rejoinder of claims 21-29 if possible upon the determination of allowable subject matter.

### II. Claim rejections under 35 USC §§ 102/103

The Office Action rejected claims 1-13 and 17-33 as being anticipated by or obvious in view of one or more of the following references Jones (US 2003/0196871) and Wiley et al. (US 3,855,889). Without acquiescing in this suggestion, Applicants have amended the language of claim 1 and added claim 37 to more specifically define the shaping of the food product slices ***"compressing the front shaped slice wherein the speed of the front shaped slice is reduced relative to the successive rear shaped slice so that the rear shaped slice is pushed up against the front shaped slice due to the greater speed of the rear shaped slice while reducing the spacing between the front shaped slice and the rear shaped slice"*** to overcome the rejection. On this basis, Applicants respectfully request reconsideration of the rejected claims and also request that the claims be allowed.

#### a. Lack of Fact Finding

The Office Action does not set forth sufficient fact findings to support the rejection under 35 U.S.C. § 103 of claims 19-21.

The office action fails to each of the differences between the claimed invention and the cited art; therefore, a prima facie case of obviousness has not been established. Foremost, the office action makes reference to "the food product slices are folded and/or fluted" and "the change in spacing during conveying of the food product slices is brought

about by changing the relative speed of two successive food products slices"; however, the office action fails to point out with any particularity why Jones and Wiley are combinable. The Office Action only argues that "it would be obvious to one skilled in the art at the time the invention was made to incorporate the step of folding the food product slices into the Jones' method for folding the food product slices."

Applicant, in view of the lack of fact finding points out it is the duty of the Examiner to act as the fact finder. Specifically, the Applicant points to Federal Register Vol. 72, No. 195 page 57527 where the USPTO points out that it is the Office Personnel that acts as the Factfinder. The Office Action fails to point to any facts that support the rejection. The Office Action only lists a conclusion, which is that this feature is obvious to one skilled in the art. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007) said, "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" KSR, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)). A claim that is "composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art." *KSR Int'l Co. v. Teleflex, Inc.* 127 S. Ct. 1727, 1741 (2007). [I]nventions in most, if not all, instances rely upon building blocks long since discovered, and claimed discoveries almost of necessity will be combinations of what in some sense, is already known." *Id.*

Furthermore, the claims as amended include a step of reshaping the food product slices by compressing successive food product slices (for further reducing spacing therebetween) through the reduction of speed between the two conveyor belts. The Office Action suggests that Jones teaches that food production slices are slowed down and piled up, however Jones fails to disclose compression of the two successive food products. Even if Jones does teach compression of the food product slices, Jones would then teach away from Wiley such that the modification of Wiley (in combination with Jones) to arrive at the at the Applicant's claimed invention would defeat the purpose of Wiley. Wiley discloses on page 7 lines 37-42 "so that even for those softer food products, the entire loaf is more readily moved as a rigid object and does not have the tendency of distorting, compressing and the like, thereby further improving the uniformity of the slices obtained through the present invention apparatus." See *In re*

**Ratti**, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959). See also *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992). Withdrawal of the rejection is therefore respectfully requested.

III. Support for Claim Language under 35 USC §112

Applicants have amended claims 18 and added claims 30-37 to additionally describe the method of the present invention. Support for the amended claim 18 and newly added claim 37 under 35 USC §112 can be found on page 3 at paragraphs [0035] and [0036] with reference to "piled-up" or as additionally translated to mean "tossed," "compressed," or "squashed" from the German word "gestaucht" or "gestauchte" as filed in WO2005/087456 at pages 8 and 9 from the priority documents DE102004007482.5 and DE102004007671.5 for "*compressing the front shaped slice wherein the speed of the front shaped slice is reduced relative to the successive rear shaped slice so that the rear shaped slice is pushed up against the front shaped slice due to the greater speed of the rear shaped slice while reducing the spacing between the reshaped front slice and the rear shaped slice*" and on page 1 at paragraph [0008] for "*such that the front shaped slice and the rear shaped slice do not lie flat on the means.*" Support for the amended claims 30 and 37 under 35 USC § 112 can on page 3 at paragraph [0035] for "*wherein the rear slice is pushed up against the front slice such that the front slice does not stick to the rear slice.*" Support for the amended claims 31 and 37 under 35 USC § 112 can on page 1 at paragraph [0010] for "*wherein the rear slice is pushed up against the front slice such that the shape of the front slice and the rear slice are changed.*" Support for the amended claims 32 and 37 under 35 USC § 112 can on page 1 at paragraph [0015] for "*wherein the means includes a first conveyor belt and a second conveyor belt such that the shaped food product slices are deposited on the first conveyor belt and transferred to the second conveyor belt which exhibits a slower conveying speed than the first conveyor belt.*" Support for the amended claims 33 and 38 under 35 USC § 112 can on page 1 at paragraph [0015] for "*wherein the first conveyor belt and the second conveyor belt form a conveying plane.*" Support for the amended claim 34 under 35 USC § 112 can on page 1 at paragraph [0016] for "*wherein the first conveyor belt is arranged above the second conveyor belt such that the shaped food products fall from the first conveyor belt onto the second conveyor belt.*" Support

for the amended claim 35 under 35 USC § 112 can on page 1-2 at paragraph [0016] for *"wherein the conveying speed of the second conveyor belt is less than the sum of the conveying speed of the first conveyor belt plus the speed at which the food product slice falls from the first conveyor belt onto the second conveyor belt."* Support for the amended claims 36 and 37 under 35 USC § 112 can on page 2 at paragraph [0034] for *"wherein the shaping of the food product slices includes contacting the food product slice with rollers of a product folder so that after contact with the product folder, the kinetic energy of the food product slice is sufficient for food product slice to achieve a folded position."* On this basis, Applicants respectfully request reconsideration of the rejected claims and also request that the claims be allowed.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

### CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

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Respectfully submitted,



David A. Zdurne  
Registration No. 58,630  
DOBRUSIN & THENNISCH PC  
29 W. Lawrence Street  
Suite 210  
Pontiac, MI 48342  
(248) 292-2920

Customer No. 25215